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EXAMINER NGUYEN, TUAN HOANG				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/965,784

Applicant(s)

MCELWAIN ET AL.

Examiner

TUAN H. NGUYEN

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19, 20 and 22-32 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 and 22-27 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-13, 15-17, 19, 28-30 and 32 is/are rejected.
- 7) ☒ Claim(s) 6, 14 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 06/20/2008 have been fully considered but they are not persuasive.

In response to Applicant's remark on page 13, Applicant argues that Bridges et al. (US PUB. 2003/0186695 hereinafter, "Bridges") in view of Mauney et al. (US PUB. 2005/0159107 hereinafter, "Mauney") references cited by the Examiner does not disclose or suggest "identifying a plurality of system identifications having a common spatial characteristic," then "storing the identified plurality of system identifications in a memory that is accessible by a mobile station," and then "comparing a system identification received from a wireless service provider to the stored plurality of system identifications". Examiner respectfully disagrees with the Applicant argument. Applicant should refer to Bridges reference page 2 [0013], page 3 [0028], page 7 [0060] and [0064] where as the Examiner interpreted "identifying a plurality of system identifications having a common spatial characteristic," i.e., two cellular subscribers who roam into a geographic area (e.g., Austin) from the same market (e.g., Dallas). If one subscriber desires to receive Short Message Service, they may roam to a service provider supporting that service (e.g., Service Provider A) while the other subscriber who requires only voice (a class of service hereinafter referred to as wireless POTS (Plain Old Telephone Service)) may roam to another service provider providing a more attractive roaming rate (e.g., Service Provider B)) then "storing the identified plurality of

system identifications in a memory that is accessible by a mobile station," i.e., the mobile station may include a memory device, such as a number assignment module (NAM), in which an assigned phone number and a system identification code (SID) and/or System Operator Code (SOC) is stored to uniquely identify the home service provider for the unit and then "comparing a system identification received from a wireless service provider to the stored plurality of system identifications" i.e., the mobile station determines whether it is in its home system or market area. Whether or not the mobile station is located in its home market area may be determined by analyzing the SID, SOC or equivalent system identification number of the cellular service provider for the area in which the mobile station is located. By comparing the SID or SOC received on the control channel with the home SID or SOC of the home service provider, the mobile station may determine whether it is located in its home system. Similar to the discussion above, claims 10, 17, and 32 are the same arguments. Therefore, the teaching of the prior art references still read on.

Base on the above rational, it is believed that the claimed limitations are met by the references submitted and therefore, the rejection maintained.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 02/21/2002 and 01/23/2003 has been considered by Examiner and made of record in the application file.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges et al (US PUB. 2003/0186695 hereinafter, "Bridges") in view of Mauney et al. (US PUB. 2005/0159107 hereinafter, "Mauney").

Consider claim 1, Bridges teaches a method comprising: storing a system identification that identifies a home service provider for the mobile station (page 2 [0013] and page 3 [0028]); identifying a plurality of system identification having a common spatial characteristic (page 7 [0064] i.e., an example of two cellular subscribers (read on "plurality of system identification") who roam into a geographic area (e.g., Austin) from the same market (e.g., Dallas, read on "common partial characteristics"); storing the identified plurality of system identification in a memory that is accessible by a mobile station (page 2 [0013] and page 3 [0028]); comparing a system identification received from a wireless service provider to the stored plurality of system identification (page 7 [0060]).

Bridges does not explicitly show that upon any one of the plurality of stored system identification matching the received system identification, declaring the wireless service provider as being a home service provider for the mobile station.

In the same field of endeavor, Mauney teaches upon any one of the plurality of stored system identification matching the received system identification, declaring the wireless service provider as being a home service provider for the mobile station (page 2 [0039]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, upon any one of the plurality of stored system identification matching the received system identification, declaring the wireless service provider as being a home service provider for the mobile station, as taught by Mauney, in order to provide a wireless handset that has enhanced operating features, including the capability of operating either within a wireless network or outside of a wireless network in a direct handset-to-handset communication mode.

Consider claim 32, Bridges teaches an apparatus, comprising: a wireless controller; a wireless transceiver controlled by the wireless controller (page 2 [0013]); and at least one memory, the at least one memory comprising a location for storing a system identification that identifies a home service provider for the apparatus, wherein said wireless controller is configured to identify a plurality of system identifications having a common spatial characteristic (page 7 [0064] i.e., an example of two cellular subscribers (read on "plurality of system identification") who roam into a geographic area (e.g., Austin) from the same market (e.g., Dallas, read on "common partial characteristics"); configured to store the identified plurality of system identifications having the common spatial characteristic in the at least one memory (page 2 [0013] and

page 3 [0028]); configured to compare a system identification received from a wireless service provider to the stored plurality of system identifications (page 7 [0060]).

Bridges does not explicitly show that upon any one of the plurality of stored system identifications matching the received system identification, configured to declare the corresponding wireless service provider as being a home service provider for the apparatus.

In the same field of endeavor, Mauney teaches upon any one of the plurality of stored system identifications matching the received system identification, configured to declare the corresponding wireless service provider as being a home service provider for the apparatus (page 2 [0039]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, upon any one of the plurality of stored system identifications matching the received system identification, configured to declare the corresponding wireless service provider as being a home service provider for the apparatus, as taught by Mauney, in order to provide a wireless handset that has enhanced operating features, including the capability of operating either within a wireless network or outside of a wireless network in a direct handset-to-handset communication mode.

5. Claims 4, 7, 9-10, 12, 15, 17, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges in view of Mauney and further in view of McGregor et al. (U.S. PUB. 2001/0000777 hereinafter, "McGregor").

Consider claim 4, Bridges and Mauney, in combination, fail to teach the common spatial characteristic (information of the system operator code) is comprised of a geographical area that corresponds to a postal zone.

However, McGregor teaches the steps of identifying, storing, comparing and declaring are executed only if the mobile station is classified as being in a Prepaid mode of operation (page 12 claim 25).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of McGregor into view of Bridges and Mauney, in order to provide the mobile phone unit having an internal processor with accessible internal memory for storing the accounting program and call data for each call.

Consider claim 7, Bridges and Mauney, in combination, fail to teach displaying a message to a user for informing the user that the user is operating in a Prepaid mode with one of a plurality of system providers having system identification that are associated with a geographical area that is the user's home geographical area.

However, McGregor teaches displaying a message to a user for informing the user that the user is operating in a Prepaid mode with one of a plurality of system providers having system identification that are associated with a geographical area that is the user's home geographical area (page 12 claim 25).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of McGregor into view of Bridges and Mauney,

in order to provide the mobile phone unit having an internal processor with accessible internal memory for storing the accounting program and call data for each call.

Consider claim 9, McGregor further teaches the common spatial characteristic is comprised of a geographical area that is defined by information received from a customer of a prepaid service provider (page 12 claim 25).

Consider claim 10, Bridges teaches a wireless communication system of a type that transmits system identification parameters to mobile stations, a list containing a plurality of other system identification having a common spatial characteristic (page 7 [0064] i.e., an example of two cellular subscribers (read on "a list containing a plurality of SID") who roam into a geographic area (e.g., Austin) from the same market (e.g., Dallas, read on "common partial characteristics"), the mobile station comprising a processor that is coupled to the at least one memory and that is responsive to a received system identification for comparing the received system identification to the system identification in the list of system identification (page 7 [0060]).

Bridges does not explicitly show that upon any one of the plurality of system identification matching the received system identification, declaring a wireless service provider that transmitted the system identification as being the Home service provider for the mobile station.

In the same field of endeavor, Mauney teaches upon any one of the plurality of system identification matching the received system identification, declaring a wireless

service provider that transmitted the system identification as being the Home service provider for the mobile station (page 2 [0039]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, a list containing a plurality of other system identification having a common spatial characteristic; and upon any one of the plurality of system identification matching the received system identification, declaring a wireless service provider that transmitted the system identification as being the Home service provider for the mobile station, as taught by Mauney, in order to provide a wireless handset that has enhanced operating features, including the capability of operating either within a wireless network or outside of a wireless network in a direct handset-to-handset communication mode.

Bridges and Mauney, in combination, fail to teach in mobile stations associated with a prepaid service provider at least one memory storing a system identification that identifies a Home service provider for the mobile station.

However, McGregor teaches in mobile stations associated with a prepaid service provider at least one memory storing a system identification that identifies a Home service provider for the mobile station (page 2 claim 25).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of McGregor into view of Bridges and Mauney, in order to provide the mobile phone unit having an internal processor with accessible internal memory for storing the accounting program and call data for each call.

Consider claim 12, McGregor further teaches the common spatial characteristic is comprised of a geographical area that is defined by information received from a customer of the prepaid service provider (page 12 claim 19).

Consider claim 15, McGregor further teaches a display for displaying a message to a user for informing the user that the user is operating in a Prepaid mode with one of a plurality of system providers having system identification that are associated with a geographical area that is the user's home geographical area (page 12 claim 25).

Consider claim 17, Bridges teaches a mobile station, comprising: a controller (page 17 claim 1); a wireless transceiver (page 1 [0008]).

Bridges does not explicitly show that at least one memory comprising a location for storing a home system identification and other locations configured to store a plurality of cousin system identification, wherein said wireless controller is configured to declare a system identification received through said wireless controller to be a home service provider if the received system identification matches the stored home system identification or any one of the plurality of stored cousin system identification.

In the same field of endeavor, Mauney teaches at least one memory comprising a location for storing a home system identification and other locations configured to store a plurality of cousin system identification, wherein said wireless controller is configured to declare a system identification received through said wireless controller to be a home service provider if the received system identification matches the stored

home system identification or any one of the plurality of stored cousin system identification (page 2 [0039]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use at least one memory comprising a location for storing a home system identification and other locations configured to store a plurality of cousin system identification, wherein said wireless controller is configured to declare a system identification received through said wireless controller to be a home service provider if the received system identification matches the stored home system identification or any one of the plurality of stored cousin system identification, as taught by Mauney, in order to provide a wireless handset that has enhanced operating features, including the capability of operating either within a wireless network or outside of a wireless network in a direct handset-to-handset communication mode.

Bridges and Mauney, in combination, fail to teach the at least one memory is configured to store the cousin system identifications under the direction of a prepaid service provider, and the cousin system identifications correspond to system identifications associated with one or more service providers that service a predetermined geographical area that is defined to be a non-roaming area of a customer of the prepaid service provider, wherein the home system identification is configured to be stored in at least one memory without the direction of a prepaid service provider.

However, McGregor teaches the at least one memory is configured to store the cousin system identifications under the direction of a prepaid service provider, and the

cousin system identifications correspond to system identifications associated with one or more service providers that service a predetermined geographical area that is defined to be a non-roaming area of a customer of the prepaid service provider, wherein the home system identification is configured to be stored in at least one memory without the direction of a prepaid service provider (page 12 claim 25).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of McGregor into view of Bridges and Mauney, in order to provide the mobile phone unit having an internal processor with accessible internal memory for storing the accounting program and call data for each call.

Consider claim 28, Bridges further teaches the at least one memory is removable from the mobile station (page 5 [0046]).

6. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges in view of Mauney and further in view of Mizikovsky (U.S. PAT. 5,983,115).

Consider claim 2, Bridges and Mauney, in combination, fail to teach the common spatial characteristic (information of the system operator code) is comprised of a geographical area that corresponds to a postal zone.

However, Mizikovsky teaches the common spatial characteristic (information of the system operator code SOC) is comprised of a geographical area that corresponds to a postal zone (col. 2 lines 54-64, fig. 2 illustrates a map of the United State cities

such as Seattle, Chicago, and Washington D.C. had the same system operator code may be found in several different locations although on different frequency bands).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Mizikovsky into view of Bridges and Mauney, in order to locate a wireless service provider in a multi-service provider environment using a stored list of preferred service providers.

Consider claim 3, Mizikovsky further teaches the common spatial characteristic (information of the system operator code SOC) is comprised of a geographical area that corresponds to a ZIP code (col. 2 lines 54-64, Fig. 2 illustrates a map of the United State cities such as Seattle, Chicago, and Washington D.C. had the same SOC may be found in several different locations although on different frequency bands).

7. Claims 5, 8, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges in view of Mauney and further in view of Bamburak et al. (U.S PAT. 6,807,418 hereinafter, "Bamburak").

Consider claim 5, Bridges and Mauney, in combination, fail to teach if none of the plurality of stored system identification matches the received system identification, further comprising comparing the received system identification to other stored system identification, including at least one of a Partner system identification, a Favored system identification and a Forbidden system identification.

However, Bamburak teaches if none of the plurality of stored system identification matches the received system identification, further comprising comparing the received system identification to other stored system identification, including at least one of a Partner system identification, a Favored system identification and a Forbidden system identification (col. 11 lines 22-29).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Bamburak into view of Bridges and Mauney, in order to provide a method for locating a particular or desirable communications service provider in an environment having a plurality of service providers.

Consider claim 8, Bamburak further teaches the step of comparing includes a preliminary step of comparing the received system identification to the stored system identification that identifies the Home service provider for the mobile station, and upon a match declaring the service provider to be the Home service provider, and inhibiting the execution of the step of comparing the system identification received from a wireless service provider to the stored plurality of system identification (fig. 4 col. 5 line 20 through col. 6 line 7).

Consider claim 19, Bamburak further teaches the Cousin SIDs are stored in a memory that is detachable from said mobile station (col. 7 lines 2-11).

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges in view of Mauney and McGregor, and further in view of Mizikovsky (U.S. PAT. 5,983,115).

Consider claim 11, Bridges, Mauney and McGregor, in combination, fail to teach the common spatial characteristic is comprised of a postal zone, such as a ZIP code.

However, Mizikovsky teaches the common spatial characteristic is comprised of a postal zone, such as a ZIP code (col. 2 lines 54-64, Fig. 2 illustrates a map of the United State cities such as Seattle, Chicago, and Washington D.C. had the same SOC may be found in several different locations although on different frequency bands).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Mizikovsky into view of Bridges, Mauney and McGregor, in order to locate a wireless service provider in a multi-service provider environment using a stored list of preferred service providers.

9. Claims 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges in view of Mauney and McGregor, and further in view of Bamburak.

Consider claim 13, Bridges, Mauney and McGregor, in combination, fails to teach if none of the plurality of other system identification matches the received system identification, the processor compares the received system identification to other stored system identification found in an Intelligent Roaming Data Base (IRDB).

However, Bamburak teaches if none of the plurality of other system identification matches the received system identification, the processor compares the received system identification to other stored system identification found in an Intelligent Roaming Data Base (IRDB) (col. 5 lines 41-48 and col. 10 lines 9-21).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Bamburak into view of Bridges, Mauney and McGregor, in order to provide a method for locating a particular or desirable communications service provider in an environment having a plurality of service providers.

Consider claim 16, Bamburak further teaches the processor first compares the received system identification to the stored system identification that identifies the Home service provider for the mobile station, and upon a match declares the service provider to be the Home service provider, and inhibits comparing the received system identification the list of other system identification (fig. 4 col. 5 line 20 through col. 6 line 7).

10. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bridges and Mauney, and further in view of Osmani et al. (U.S. PAT. 5,815,807 hereinafter, "Osmani").

Consider claim 29, Bridges, Mauney and McGregor, in combination, fails to teach the mobile station operates in a Postpaid mode.

However, Osmani teaches the mobile station operates in a Postpaid mode (col. 1 lines 42-49).

Therefore, it is obvious to one of ordinary skill in the art at the time the invention was made to incorporate the disclosing of Osmani into view of Bridges, Mauney and McGregor, in order to enhance a wireless communication device operates in a wireless communication system to provide a user of the device with portable communications.

Consider claim 30, Osmani further teaches the mobile station has both Postpaid and Prepaid modes (col. 1 lines 42-49).

Allowable Subject Matter

11. Claims 6, 14, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons for Allowance

12. Claims 20 and 22-27 are allowed over the prior art record.

13. The following is an examiner's statement of reasons for allowance:

The applicant's remarks, filed on 06/20/2008, have been carefully reviewed with updated search. Consequently, reasons for allowance of claims 20 and 22-27 are set forth in according to the applicant's remarks state on pages 10-22.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any response to this action should be mailed to:

Mail Stop _____ (Explanation, e.g., Amendment or After-final, etc.)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan H. Nguyen whose telephone number is (571)272-8329. The examiner can normally be reached on 8:00Am - 5:00Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Maung Nay A. can be reached on (571)272-7882882. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information Consider the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan Nguyen/
Examiner
Art Unit 2618

/Nay A. Maung/
Supervisory Patent Examiner, Art
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